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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/690,867  | 10/22/2003  | Michael J. Wookey    | 30014200-1118       | 6920             |
| 58328   | 7590        | 10/10/2007           | EXAMINER            |                  |
| SUN MICROSYSTEMS<br>C/O SONNENSCHEIN NATH & ROSENTHAL LLP<br>P.O. BOX 061080<br>WACKER DRIVE STATION, SEARS TOWER<br>CHICAGO, IL 60606-1080 |             |                      | KEEPER, MICHAEL E   |                  |
| ART UNIT  |             | PAPER NUMBER         |                     |                  |
| 2154  |             |                      |                     |                  |
| MAIL DATE   |             | DELIVERY MODE        |                     |                  |
| 10/10/2007  |             | PAPER                |                     |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|------------------------------|------------------------|---------------------|--|
|                              | 10/690,867             | WOOKEY, MICHAEL J.  |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Michael E. Keefer      | 2154                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 22 October 2003.

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-8 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) \_\_\_\_\_ is/are rejected.  
7)  Claim(s) \_\_\_\_\_ is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5)  Notice of Informal Patent Application  
6)  Other: \_\_\_\_\_.  
\_\_\_\_\_

## DETAILED ACTION

1. This Office Action is responsive to the Application filed 10/22/2003.

### *Specification*

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### *Claim Rejections - 35 USC § 101*

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 4-6 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claims 4-6, the "computer readable medium," in accordance with Applicant's specification, may be a carrier wave (page 11 lines 32-33). This subject matter is not limited to that which falls within a statutory category of invention because it is not limited to a process, machine, manufacture, or a composition of matter. Instead, it includes a form of energy. Energy does not fall within a statutory category since it is clearly not a series of steps or acts to constitute a process, not a mechanical device or combination of mechanical devices to constitute a machine, not a tangible physical article or object which is some form of matter to be a product and constitute a manufacture, and not a composition of two or more substances to constitute a composition of matter.

The examiner suggests in order to overcome this rejection, the applicant amend the specification to include computer readable storage media such as (hard disks, etc.

as listed in line 32 on page 11) and computer readable transmission media such as (a carrier wave...). Then amend claims 4-6 to be directed to the "computer readable storage media". This will prevent a new matter by deletion objection to an amendment to the specification solely deleting the reference to carrier waves, while simultaneously clarifying that claims 4-6 are only directed to statutory subject matter (i.e. not transmission media, e.g. carrier waves.).

***Claim Rejections - 35 USC § 102***

4. Claims 1-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Agassi et al. (US 2003/0217061), hereafter Agassi.

Regarding **claims 1, 4, and 7-8**, Agassi discloses:

providing a first processing engine to determine a solution to a problem, wherein the first processing engine subscribes to at least one of a plurality of datatypes that each contains a reference to a respective data item maintained separately from the plurality of datatypes, ([0084] content based routers receive only links to corresponding articles, but are sent with the associated metadata pertaining to the articles)

executes a processing using the data item responsive to receiving the subscribed to datatype, and publishes a processing result including a second datatype; and providing a second processing engine that subscribes to the second datatype published by the first processing engine. ([0088]-[0089] disclose filtering (i.e. subscribing) to certain articles, which are then transformed into

pages which contain supplemental articles (creating a new datatype) which is subscribed to by the end user's computer (i.e. the second processing engine).

**Regarding claims 2 and 5 as applied to claims 1 and 4, Agassi discloses:**

Retrieving a copy of the data item after receiving the datatype. ([0090]) discloses retrieving the articles for pagination after a link and metadata have been received.)

**Regarding claims 3 and 6 as applied to claims 1 and 4, Agassi discloses:**

Saving the second datatype responsive to publishing the second datatype. ([0099] discloses that the articles (i.e. second datatypes created by pagination) can be pre-assembled for the user. In order for them to be assembled before the user requests them, it is inherent that they must be stored or saved for some period of time until the user requests to see them.)

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael E. Keefer whose telephone number is (571) 270-1591. The examiner can normally be reached on Monday through Friday 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached on (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MEK 9/27/2007



**NATHAN FLYNN**  
SUPERVISORY PATENT EXAMINER